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10/579,558	05/16/2006	Motoji Ohmori	2006_0739A	3255
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EXAMINER				
NIGH, JAMES D				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,558

Applicant(s)

OHMORI ET AL.

Examiner

JAMES D. NIGH

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009 and 28 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 14-21 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 29 April 2009 and 28 May 2009 have been entered.

Claim Status

2. Claims 1-13 have been cancelled and claims 14-21 have been added. Claims 14-21 are currently pending and are presented for examination on the merits.

Response to Amendment

3. Amended claims 14-16 recite a license information management apparatus and further recite a digital signature management unit configured to verify the validity of the encrypted information by the steps of reading the encrypted information, generating a hash value and comparing two hash values which are method steps. A claim which recites both an apparatus and a method of using the apparatus is a hybrid claim which has been ruled to be indefinite under 35 U.S.C. § 112, 2nd paragraph. Therefore as claims 14-16 possess such a deficiency they are rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

4. Amended claims 14-16 and 20-21 recite a license information management apparatus, method and computer readable medium and further recite "(i) generate a hash value of the encrypted information before the encrypted information is stored into the storage unit, and hold the generated hash value, and (ii) verifying the validity of the encrypted information by reading the encrypted information stored in the storage unit, generating a hash value of the read encrypted information, and comparing the generated hash value of the encrypted information before the encrypted information is stored into the storage unit with the generated hash value of the read encrypted information". It would appear to a person of ordinary skill in the art that the act of storing the encrypted information would never occur unless the contents of the encrypted information already in possession of the storage unit were identical to those being held; otherwise the generated hash values would never match. As the invention is directed towards a "content reproduction condition information indicating a range in which the digital content can be used" and the tamper resistance module is the only claimed structure capable of storing information in the storage unit claims 14-16 and 20-21 are rejected as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As it would also not be possible "to overwrite and store the encrypted updated license information into the storage unit, when the digital content is used and only when the digital signature management unit verifies the validity" as

claimed this limitation is also rejected form not enabling one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Amended claims 14-16 and 20-21 recite within the claim limitations the word "hold" or "holding". It is not clear what if any action is required to "hold"; therefore as the scope of the claim cannot be ascertained the claim must be ruled to be indefinite "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

6. Amended claim 14 recites "a control unit configured to decrypt the encrypted content key included in the license information decrypted by the encrypting and decrypting unit, output the decrypted content key outside of the license information management apparatus". It is unclear if a second decrypted content key that resides outside of the license information management apparatus is being outputted or if this is the same key that was decrypted by the control unit. Furthermore it is unclear from the claim as to the destination of the key being output "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

7. Amended claim 20 is directed towards non-statutory matter. The claim does not positively recite any physical structure as implementing the method steps; nor is any physical transformation occurring. The recitation of the tamper resistance module in the preamble does not make the claim statutory as it has been held that a recitation of

technology in the preamble is simply a nominal recitation of structure (*Ex parte Langemyr*, 89 USPQ2d 1988 (Bd. Pat. App. & Int. 2008). Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 20 fails prong (1) because the “tie” (e.g. stored into the storage unit and outside a license management apparatus) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

The rejection may be overcome by positively reciting the physical structure performing the methods steps within the claim limitations, such as "generating, by a tamper resistance module, a hash value".

8. Claim 21 is directed towards non-statutory matter. Claim 21 recites "A computer executable program embodied on a computer-readable medium" and further recites "said program causing a computer to execute a method comprising" however the claim is written broadly enough that the program could be composed of pseudocode and in the broadest reasonable interpretation would be non-statutory. The rejection may be overcome by reciting "computer-readable storage medium encoded with computer-executable instructions when executed by a computer causes the computer to perform the steps of".

Response to Arguments

9. Applicant's argument with regard to the 35 U.S.C. § 102 (b) rejection of claim 14 that "that Hori does not disclose, suggest or render obvious the above-noted feature recited in claim 14 of a digital signature management unit configured to (i) generate a hash value of the encrypted information before the encrypted information is stored into the storage unit, and hold the generated hash value, and (ii) verifying the validity of the encrypted information by reading the encrypted information stored in the storage unit, generating a hash value of the read encrypted information, and comparing the generated hash value of the encrypted information before the encrypted information is stored into the storage unit with the generated hash value of the read encrypted information, the validity indicating that the encrypted information has not been tampered

with" has been fully considered but is not persuasive. As the argument is directed towards subject matter that is not enabling this does not render the a finding of either anticipation or obviousness invalid.

10. Applicant's arguments with regard to claims 20 and 21 have been fully considered but are not persuasive. As the argument is directed towards subject matter that is not enabling this does not render the a finding of either anticipation or obviousness invalid.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 20-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

13. Amended claim 20 is directed towards non-statutory matter. The claim does not positively recite any physical structure as implementing the method steps; nor is any physical transformation occurring. The recitation of the tamper resistance module in the preamble does not make the claim statutory as it has been held that a recitation of technology in the preamble is simply a nominal recitation of structure (*Ex parte Langemyr*, 89 USPQ2d 1988 (Bd. Pat. App. & Int. 2008). Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 20 fails prong (1) because the "tie" (e.g. stored into the storage unit and outside a license management apparatus) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

The rejection may be overcome by positively reciting the physical structure performing the methods steps within the claim limitations, such as "generating, by a tamper resistance module, a hash value".

14. Claim 21 is directed towards non-statutory matter. Claim 21 recites "A computer executable program embodied on a computer-readable medium" and further recites "said program causing a computer to execute a method comprising" however the claim is written broadly enough that the program could be composed of pseudocode and in

the broadest reasonable interpretation would be non-statutory. The rejection may be overcome by reciting "computer-readable storage medium encoded with computer-executable instructions when executed by a computer causes the computer to perform the steps of".

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. **Claims 14-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

17. Amended claims 14-16 and 20-21 recite a license information management apparatus, method and computer readable medium and further recite "(i) generate a hash value of the encrypted information before the encrypted information is stored into the storage unit, and hold the generated hash value, and (ii) verifying the validity of the encrypted information by reading the encrypted information stored in the storage unit, generating a hash value of the read encrypted information, and comparing the generated hash value of the encrypted information before the encrypted information is stored into the storage unit with the generated hash value of the read encrypted information". It would appear to a person of ordinary skill in the art that the act of storing

the encrypted information would never occur unless the contents of the encrypted information already in possession of the storage unit were identical to those being held; otherwise the generated hash values would never match. As the invention is directed towards a "content reproduction condition information indicating a range in which the digital content can be used" and the tamper resistance module is the only claimed structure capable of storing information in the storage unit claims 14-16 and 20-21 are rejected as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As it would also not be possible "to overwrite and store the encrypted updated license information into the storage unit, when the digital content is used and only when the digital signature management unit verifies the validity" as claimed this limitation is also rejected form not enabling one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. **Claims 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

20. Amended claims 14-16 recite a license information management apparatus and further recite a digital signature management unit configured to verify the validity of the encrypted information by the steps of reading the encrypted information, generating a

hash value and comparing two hash values which are method steps. A claim which recites both an apparatus and a method of using the apparatus is a hybrid claim which has been ruled to be indefinite under 35 U.S.C. § 112, 2nd paragraph. Therefore as claims 14-16 possess such a deficiency they are rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

21. Amended claims 14-16 and 20-21 recite within the claim limitations the word "hold" or "holding". It is not clear what if any action is required to "hold"; therefore as the scope of the claim cannot be ascertained the claim must be ruled to be indefinite "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

22. Amended claim 14 recites "a control unit configured to decrypt the encrypted content key included in the license information decrypted by the encrypting and decrypting unit, output the decrypted content key outside of the license information management apparatus". It is unclear if a second decrypted content key that resides outside of the license information management apparatus is being outputted or if this is the same key that was decrypted by the control unit. Furthermore it is unclear from the claim as to the destination of the key being output "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

23. Claims 15-19 are also rejected as being dependent upon claim 14.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (U.S. Patent PG Publication 2002/0184154, now U.S. Patent 7,340,055, hereinafter referred to as Hori).**

26. As per claims 14, 20 and 21

Hori discloses encrypting the license information and storing the encrypted license information in the storage unit (0136, 0177, 0199, 0204, 0239)

Hori discloses reading the encrypted license information from the storage unit and decrypting the read encrypted license information (Figure 12, 0100, 0135, 0176, 0238)

Hori discloses decrypting the encrypted content key included in the license information (Figure 20, Figure 23, 0166, 0175, 0221, 0227, 0228)

Hori discloses outputting the decrypted content key (0074, 0095)

Hori discloses updating the content reproduction condition information included in the decrypted license information (0074, 0077)

Hori explicitly discloses storing in the storage unit (0085, 0086, 0102, 0114, 0256)

Hori does not explicitly disclose generating a hash value of the encrypted information. Hori teaches generating a hash value of the information and then encrypting the hash (0222-0223). It has been held by the courts that the sequence of steps does not render invalid a *prima facie* finding of obviousness (*Ex parte Rubin* , 128 USPQ 440 (Bd. App. 1959)

Hori does not explicitly disclose verifying validity of the encrypted information by reading the encrypted information stored in the storage unit, generating a hash value of the read encrypted information, and comparing the generated hash value of the encrypted information before the encrypted information is stored into the storage unit with the generated hash value of the read encrypted information. Hori teaches receiving an encrypted hash value, decrypting the encrypted hash value, and comparing to a generated digital signature (0222-0228). It has been held by the courts that the sequence of steps does not render invalid a *prima facie* finding of obviousness (*Ex parte Rubin* , 128 USPQ 440 (Bd. App. 1959).

27. As per claim 15

Hori discloses the limitations carried from claim 14 plus the following:

Hori discloses wherein the encrypting and decrypting unit is configured to encrypt each of a plurality of pieces of license information, and store each piece of encrypted license information in the storage unit (0049, 0093, 0095).

28. As per claim 16

Hori discloses the limitations carried from claim 14 plus the following:

Hori does not explicitly disclose wherein the encrypting and decrypting unit is further configured to (i) encrypt the correspondence table and store the encrypted correspondence table in the storage unit; however as Hori teaches a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235), an encryption unit (0015-0017) and a storage unit (0011-0018) a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Hori would be to use the encryption unit to encrypt the correspondence table and store the result in the storage unit for the purpose of providing a data distribution system

Hori does not explicitly disclose a unit configured to read the stored correspondence table from the storage unit and decrypt the read correspondence table; however as Hori teaches a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235), an decryption unit (0015-0017) and a storage unit (0011-0018) therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Hori would be to read the stored correspondence table from the storage unit and use the decryption unit to decrypt the correspondence table for the purpose of providing a data distribution system

"the correspondence table being a table in which identification information identifying the license information is stored in association with information indicating an update history of the license information for each of a plurality of pieces of license information stored in the storage unit" is simply descriptive material and as the claimed data has no manipulative effect on any of the structure it is nonfunctional in nature and therefore is not entitled to any patentable weight "Where the printed matter is not

functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, "We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability", *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008); however Hori teaches a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235).

29. As per claim 17

Hori discloses the limitations carried from claim 16 plus the following:

Hori discloses wherein corresponding information indicating the update history indicates the number of updates or a random number (0074)

Hori discloses wherein the control unit is further configured to update the corresponding information of the correspondence table indicating the number of updates or the random number (0074)

30. As per claim 18

Hori does not explicitly disclose determining if license is new. However, Hori teaches a license information hold unit (0177, 0199, 0204, 0210) and specifically

teaches checking to see if a status flag (0210) is set to FFh indicating that no transaction ID is present; therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Hori would be to query the license information hold unit to see if the status was set to FFh in which case it would be assumed that the content was new for the purpose of providing a data distribution system

31. As per claim 19

Hori explicitly discloses data management unit is an IC card (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

Hori explicitly discloses a data management unit having tamper resistance (0103-0106)

Hori does not explicitly disclose that the storage unit is flash memory. However, Hori teaches that the memory can be read and written to which is a characteristic of flash memory (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

"One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/
Examiner, Art Unit 3685

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621